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10/626,183

07/24/2003

Gregory Louis Truty

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IBM CORP (WSM)

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EXAMINER

WANG, LIANG CHE A

ART UNIT

PAPER NUMBER

2155

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/626,183

Applicant(s)

TRUTY, GREGORY LOUIS

Examiner

Liang-che Alex Wang

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-20 are presented for examination.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title

3. Claims 8-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to software per se, which does not fall into the categories of “process”, “machine”, “manufacture” and “composition of matter”. Referring to claim 8, claim 8 recites the limitation, “program product”, which directs the claim to software per se.
4. All dependent claims are rejected to as having the same deficiencies as the claims they depend from.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5-7, 11-14, 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Referring to claims 5, 11, and 19, Claims 5, 11 and 19 recites the limitation of “by passing (a)-(c)”, which renders the claims vague and indefinite. A broad range or

limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 5, 11 and 19 recites the broad recitation which is omitting the limitations in steps (a)-(c).

8. Referring to claims 13, claims 13 recites the program product of claim 5, however, claim 5 recites a method claim. The Examiner views claim 13 as a dependent claim of claim 12 for further examination.
9. All dependent claims are rejected to as having the same deficiencies as the claims they depend from.

#### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-4, 8-11, 15-18 rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al., US Publication No. 2004/0119740A1.

12. Referring to claim 1, Chang teaches a method for collating e-mail (page 1 [0007]) comprising:

- a. differencing (page 1 [0007] page 4 [0054], where the detecting repeated text of first and second messages corresponds to “differencing”) at least one first e-mail message (Chang’s second electronic message corresponds “at least one first e-mail message) to and a second e-mail message (Chang’s first electronic message corresponds “second e-mail message) wherein said at least one first e-mail message is prior to said second e-mail message(page 1 [0007] second electronic message is received prior to the first electronic message), said differencing generating a set of unmatched text (new text) and a set of matched text (repeated text) (page 4 [0054]);
- b. matching said set of matched text against a collated message file, said matching step identifying a position in said collated message file at an end of a portion of said collated message file corresponding to said set of matched text (page 4 [0054-0058]); and
- c. inserting said set of unmatched text in said collated message file at said position (page 4 [0066] and figure 7).

13. Referring to claim 2, Chang teaches the method of claim 1 wherein said at least one first e-mail message comprises a plurality of first e-mail messages (figure 7), the method further comprising:
- (d) repeating step (a) for each e-mail message of said plurality of first e-mail messages (Page 4 [0066], figure 7); and
  - (e) selecting one of said plurality of e-mail messages having a largest set of matched text, and wherein, in step (b), said largest set of matched lines is matched against said collated message file (figure 7).
14. Referring to claim 3, Chang teaches the method of claim 2 further comprising selectably adding a user-configurable identifier to said set of unmatched text inserted in step (c) (figure 7, all user identifications such as “Bog”, “George” corresponds to “a user configurable identifier”).
15. Referring to claim 4, Chang teaches the method of claim 1 wherein said at least one first e-mail message and said second e-mail message comprise a set of topically-related e-mail selected in response to a preselected pattern in a header portion of each e-mail of said set of topically-related e-mail (figures 7 and 8, the topic “hockey time” corresponds to the “topically-related”).
16. Referring to claims 8-11, 15-18 claims 8-11, 15-18 encompass the same scope of the invention as that of the claims 1-4. Therefore, claims 8-11, 15-18 are rejected for the same reason as the claims 1-4.

*Conclusion*

Art Unit: 2155

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liang-che Alex Wang whose telephone number is (571)272-3992. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.
19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571)272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Liang-che Alex Wang  
July 24, 2007

A handwritten signature in black ink, appearing to read "Lc Wang", is written over the typed name and date.